

REMARKS

This amendment is in response to the Office Action mailed September 22, 2005.

Claims 1, 3 through 6, 13 and 15 through 18 are currently pending in the application.

Claims 1, 3 through 6, 13 and 15 through 18 stand rejected.

Applicant has amended claims 1 and 13, and respectfully requests reconsideration of the application as amended herein.

Freyman teaches or describes an invention that allows for standard automolding of printed circuit boards (col. 4, lines 25-26).

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Applicant's Admitted Prior Art (AAPA) in view of U.S. Patent 5,635,671 to Freyman et al. and in view of U.S. Patent 6,221,690 B1 to Taniguchi et al.

Claims 1, 3, 4, 13, 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Freyman et al. (U.S. Patent 5,635,671) and in view of Taniguchi et al. (U.S. Patent 6,221,690 B1). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant's Admitted Prior Art (AAPA) teaches or suggests automolding systems and resist removal methods.

Taniguchi describes a semiconductor package and production method thereof. Specifically, Taniguchi describes a semiconductor package production method where a solder

resist 3 is formed on the top surface side of a BGA (ball and grid array) substrate (col. 3, lines 35-36). This solder resist is preferably one that can be removed by a laser (col. 4, line 40-42). The laser can be selected from the fundamental wave of a YAG laser, the second harmonic, the third harmonic, and fourth harmonic of the YAG laser, an excimer laser, and so on (col. 5, lines 47-51). Lastly, an encapsulating resin can be used to encapsulate the substrate (col. 6, lines 57+).

Freyman teaches or describes an invention that allows for standard automolding of printed circuit boards (col. 4, lines 25-26).

Applicant asserts that any combination of the AAPA in view of Taniguchi and in further view of Freyman fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed inventions of presently amended independent claims 1 and 13 because any combination of such cited prior art fails to teach or suggest all the claim limitations of presently amended independent claims 1 and 13. Applicant asserts that any combination of the cited prior art fails to teach or suggest the claim limitations of presently amended independent claims 1 and 13 calling for “removing at least a portion of the resist from the substrate using the laser used in the automolding system”, “placing the substrate in the molding portion of the automolding system for encapsulation of a portion thereof”, “laser etching the resist from at least a portion of the surface of the substrate using the laser in the automolding system”, and “encapsulating the substrate in the molding portion of the automolding system”.

Applicant respectfully submits there is no suggestion or motivation, either in AAPA, or Freyman or Taniguchi, to modify any of the reference or to combine reference teachings to form the claimed invention to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103. AAPA merely teaches or suggests the use of automolding systems and resist removal systems while Taniguchi does not suggest or provide evidence showing that its teachings of laser removal of resist, when combined with an automolding system, would provide a more efficient automation in manufacture; nor does Freyman suggest or hint that combining molding of printed circuit boards with the teachings of Taniguchi will provide a more efficient automation in manufacture. Applicant respectfully submits that such analysis is merely hindsight analysis and is improper. There is no suggestion, other than solely in Applicant’s specification, that the combined teachings of Taniguchi and Freyman will have a reasonable

expectation of success. Additionally, the only suggestion to combine the teachings of Taniguchi and Freyman is in Applicant's specification, which thing cannot be relied upon to form an obviousness rejection. Such a rejection is neither within the ambit nor purview of 35 U.S.C. § 103 and cannot establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103. Further, Applicant asserts that any combination of such prior art cannot and does not teach or suggest the claim limitations of presently amended independent claims 1 and 13 because any rejection based on any combination of such prior art would be a hindsight reconstruction of the presently claimed invention by picking and choosing elements and claim limitations based solely upon Applicant's disclosure because the cited prior art is devoid of any teaching or suggestion for any combination thereof. Since all rejections of the claimed inventions are based upon AAPA, Applicant asserts that the use of such prior art is *prima facie* evidence that there is no prior art that contains any teaching or suggestion of the claim limitations of the claimed inventions of independent claims 1 and 13, otherwise, other individual prior art references would have been used in any rejection, which references would teach or suggest the claimed inventions.

For these reasons, Applicant respectfully submits that, under 35 U.S.C. § 103, presently amended independent claims 1 and 13 are allowable over the combination of Taniguchi and Freyman because, at the very least, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. 103.

Obviousness Rejection Based on Applicant's Admitted Prior Art (AAPA) in view of U.S. Patent 5,635,671 to Freyman et al. and in view of U.S. Patent 6,221,690 B1 to Taniguchi et al. as applied to claims 1 and 13 above, and further in view of U.S. Patent 5,364,493 to Hunter, Jr. et al.

Claims 5, 6, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Freyman et al. (U.S. Patent 5,635,671) and in view of Taniguchi et al. (U.S. Patent 6,221,690 B1) as applied to claims 1 and 13 above,

and further in view of Hunter, Jr. et al. (U.S. Patent 5,364,493). Applicant respectfully traverses this rejection, as hereinafter set forth. Applicant asserts that Hunter does not teach or suggest any of the claim limitations of presently amended independent claims 1 and 13 because Hunter is only directed to the automation of resist removal. Since claims 5, 6, 17, and 18 are dependent claims from presently amended independent claim 1 and 13 which are allowable over the cited prior art, Applicant asserts that such dependent claims are also allowable.

CONCLUSION

Claims 1, 3 through 6, 13 and 15 through 18 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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